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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,732	03/26/2001	Walter G. Bright	41003.P076X	9469

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SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITES 1600-1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER

NGUYEN, LEE

ART UNIT PAPER NUMBER

2682

DATE MAILED: 05/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,732

Applicant(s)

BRIGHT ET AL.

Examiner

LEE NGUYEN

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the communication filed 3/1/2004.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-2, 4, 12-13, 15 and 23-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 23 of copending Application No. 09/975,287, referred to as Application'287 hereinafter. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claims 1 and 4, claim 21 of Application'287 discloses a wireless mobile phone, including a transceiver as claimed; vibrating device and an adapter interface, corresponding to the claimed means coupled, which is substantially similar to claim 1 of the present application. The wireless mobile phone of claim 21 of Application'287 inherently includes a body casing with a front face surface.

Regarding claim 2, claim 23 of Application'287 also teaches Morse codes.

Regarding claim 12, claim 21 of Application'287 direct to a wireless mobile phone, rather than a wireless pager. It is obvious that the mobile phone has similar functions of a pager. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include pager function to the mobile telephone of claim 21 in order to enhance functionality of the mobile phone.

Regarding claim 13, claim 21 of Application'287 also teaches the transceiver.

Regarding claim 15, the claim is interpreted and rejected for the same reason as set forth in claim 23 of Application'287.

Regarding claim 23, the claimed PDA is interpreted and rejected for the same reason as set forth in the pager of claim 12 of Application'287.

Regarding claim 24, the claim is interpreted and rejected for the same reason as set forth in claim 23 of Application'287.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6-11, 33 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-331407 (referred to as Patent'407 hereinafter).

Regarding claims 6, 33, Patent'407 teaches a wireless mobile phone comprising: a body casing (fig. 2a); inherently a transceiver to send and

receive signals for text message with alphanumeric data (see [0006-0014], [0033]); a vibrator 108 (fig. 1) coupled to said body casing to vibrate said wireless mobile phone; a storage medium 104, 105 (fig. 1) having stored therein a plurality of programming instructions, which when executed cause the wireless mobile phone to vibrationally output the received text messages with alphanumeric data through vibrational manifestation of the received alphanumeric data using the vibrator [0032]; and an execution unit 102 (fig. 1) coupled to the storage medium for executing the plurality of programming instructions.

Regarding claim 7, Patent'407 also teaches a fourth embodiment in which display mode and vibration mode are included in the mobile telephone (see [0009]). Therefore, Patent'407 inherently teaches a switch for switching between the two modes.

Regarding claim 8, Patent'407 also teaches that said plurality of programming instructions comprises programming instructions, which when executed cause the wireless mobile phone to vibrationally output Morse code representations of the received alphanumeric data of the received text messages (see [0032]).

Regarding claim 9, Patent'407 teaches in a wireless mobile phone, a method comprising: receiving signals representing text messages with alphanumeric data (see [0032]); determining if the mobile phone is operating in a vibrational output mode (col. 6, see the rejection of claim 7); and identifying vibrational representations of at least a portion of the alphanumeric data of the received text messages and outputting the vibrational representations if the mobile phone is operating in a vibrational output mode (see [0032]).

Regarding claim 10, the claim is interpreted and rejected for the same reason as set forth in claim 7.

Regarding claim 11, the claim is interpreted and rejected for the same reason as set forth in claim 8.

Regarding claim 38, the claim is interpreted and rejected for the same reason as set forth in claim 7.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-5, 12-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-331407 (referred to as Patent'407 hereinafter) in view of Panther et al. (US 5,263,195).

Regarding claim 1, Patent'407 teaches a wireless mobile phone (fig. 2) comprising: a body casing having a front surface (201, 206); inherently a transceiver (see [0006-0014]) send and receive signals for text messages with alphanumeric data [0033]; a vibrator 108, see [0032] coupled to said body casing to vibrate said wireless mobile phone and vibrationally outputting the received text message with alphanumeric data through

vibrational manifestation of the received alphanumeric data of the received text message data, see [0032-0033]. Patent'407 fails to teach means coupled to said vibrator and said transceiver. In other word, the vibrator is attachable to the transceiver. Panther teaches that the vibrator is attachable to a pager (col. 14, lines 11-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the detachable vibrator of Panther to the mobile phone of Patent'407 so that the vibrator load does not cause premature battery failure and mobile phone battery can be very much smaller and the battery lifetime is extended.

Regarding claim 2, Patent'407 as modified also teaches that said means for vibrationally outputting received alphanumeric data comprises means for outputting Morse code representations of the received alphanumeric data of the received text message, see [0032] of Patent'407.

Regarding claim 3, Patent'407 as modified also teaches that said vibrator is disposed within said body casing (fig. 1, numeral 108 of Patent'407).

Regarding claim 4, Patent'407 as modified also teaches that the means for vibrationally outputting received alphanumeric data comprises

means for vibrationally outputting alphanumeric data of the text message received via said transceiver (see [0032] of Patent'407).

Regarding claim 5, Patent'407 as modified teaches a keypad 206 (figs. 2a-2b of Patent'407)) that said keypad facilitates entry of alphanumeric data, and wherein said means for vibrationally outputting received alphanumeric data comprise means for vibrationally outputting alphanumeric data of a text message composed using said input keypad, see [0013] of Patent'407.

Regarding claims 12, 23 and 27, the claims are interpreted and rejected for the same reason as set forth in claim 1. Patent'407 does not teach that the mobile phone can also be a pager and a PDA. It is taken official notice that a mobile phone that can function as a two-way pager or a PDA is conventionally well known. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the pager and the PDA that function as the mobile phone of Patent'407 in order to enhance the functional operability of the mobile phone.

Regarding claim 13, Patent's 407 as modified inherently teaches a transmitter to transmit signals (see the rejection of claim 1).

Regarding claim 14, the claim is interpreted and rejected for the same reason as set forth in claim 7.

Regarding claims 15, 24, the claims are interpreted and rejected for the same reason as set forth in claim 8.

Regarding claims 16, 25, the claims are interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 26, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 17, the claim is interpreted and rejected for the same reason as set forth in claims 6 and 12.

Regarding claims 18, 28, the claims are interpreted and rejected for the same reason as set forth in claim 7.

Regarding claims 19, 29, the claims are interpreted and rejected for the same reason as set forth in claim 8.

Regarding claims 20, 30, the claims are interpreted and rejected for the same reason as set forth in claims 9 and 17.

Regarding claims 21, 31, the claims are interpreted and rejected for the same reason as set forth in claim 7.

Regarding claims 22, 32, the claims are interpreted and rejected for the same reason as set forth in claim 11.

8. Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-331407 (referred to as Patent'407 hereinafter) in view of Okano (US 6,573,825) cited in the previous action.

Regarding claims 34-37, Patent'407 does not explicitly teach multiple frequencies representing the Morse codes. In the same field, Okano teaches that the vibrator causes wireless communication device to vibrate at multiple distinct frequencies, wherein vibrations at each frequency are user distinguishable and that the vibrator causes the wireless communication device to vibrate at any two of the multiple frequencies so as to generate Morse code based vibrational representations of the received alphanumeric data and that the vibrator causes wireless communication device to vibrate for multiple distinct durations wherein each vibrational duration is user-distinguishable and that the vibrator causes the wireless communication device to vibrate at any two of the multiple distinct durations so as to generate Morse code based vibrational representations of the received alphanumeric data (see fig. 8). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Okano to the device of Patent'407 in order to let the impaired person recognize the received messages.

Response to Arguments

9. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (703)-308-5249. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5/6/04
LEE NGUYEN
Primary Examiner
Art Unit 2682